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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,481	03/04/2002	Brian D. Emberling	5181-90200	5098

7590 11/19/2003

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EXAMINER

LE, DON P

ART UNIT PAPER NUMBER

2819

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,481

Applicant(s)

EMBERLING ET AL.

Examiner

Don P Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 9-17 and 20 is/are rejected.
- 7) ☒ Claim(s) 3, 7, 8, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4-6, 9, 11-17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Sunter (US 6,492,798).

3. With respect to claims 1, 12, 13, 15-17 and 20, figure 1 of Sunter discloses an integrated circuit including logic for testing internal operation of the circuit, the circuit comprising:

A plurality of internal functional blocks 254, figure 7A, more than one circuit, each circuit is a block) coupled by a plurality of internal buses (inherently there have to be buses to connect the circuits);

A set of test control input pins (outputs of 102) comprised on the circuit;

A set of test output pins (output of 108); and

Selection logic (104, 108) comprises in the integrated circuit, wherein the selection logic comprises:

A plurality input pins (pins connected to 103) coupled to two or more of the plurality of internal buses;

At least one select input (output from 102) coupled to receive select signals from the set of test control input pins; and

An output coupled to the set of test output pins;

Wherein the selection logic is operable to select internal bus signals from one of the two or more internal buses based on the select signals from the test control input pins, wherein the selection logic is configured to output the selected internal bus signals to the set of test output pins.

4. With respect to claims 2, 9 and 11, figure 1 shows the multiplexer and demultiplexer select/demux input and output signals.
5. With respect to claim 4, the function of multiplexer is to select a signal from a group of signals.
6. With respect to claims 5 and 6, the buses are operated in parallel is a single high frequency.
7. With respect to claim 14, figure 1 of Sunter discloses parallel outputs at 108.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

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matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sunter (US 6,492,798). The apparatus of Sunter does not specifically state the integrated circuit is an ASIC as claimed by applicant. However, it is well known in the art that ASIC circuit is a subset of an integrated circuit. It would have been obvious to one of ordinary skill of art at the time the invention was made to have implemented the ASIC as taught by Sunter for the purpose of testing an ASIC.

Allowable Subject Matter

10. Claims 3, 7, 8, 18, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Don P Le whose telephone number is 703-308-4890. The examiner can normally be reached on 7AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Tokar can be reached on 703-305-3493. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7724.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

11/14/03

A handwritten signature in black ink, appearing to read 'Don Le', with a stylized flourish at the end.

DON LE
PRIMARY EXAMINER